

## **REMARKS**

### **I. Overview**

Claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34, and 37 – 47 are currently pending in the application. After entry of this amendment, claims 48 – 51 will also be pending in the application. Claims 1 – 4, 6 – 14, 16 – 19, 21 – 27, 30 – 34, and 37 – 47 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent 5,684,706 (filed May 31, 1995, issued Nov. 4, 1997) to Harman et al. (hereinafter “Harman”). Applicants traverse the current rejections and respectfully request reconsideration and withdrawal of the rejections in light of the remarks contained herein.

### **II. Amendments to the Claims**

Claims 48 – 51 are new. The new claims require that abstracting be initiated by a code embedded in the document to be printed. Support for the subject matter recited in claims 48 – 51 can be found in the Specification on page 9, lines 5 – 10. This portion of the specification provides that based on a code, the system may redirect a portion of the document presented by an application to another facility. Applicant has reviewed Harman and has not found any disclosure that a code, in the data stream, is used as recited in the claims. Accordingly, Applicant believes the new claims are patentable over Harman.

### **III. Rejections Under 35 U.S.C. § 103(a)**

The Examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. M.P.E.P. § 2142; *In re Peehs*, 612 F.2d 1287, 204 USPQ 835, 837 (CCPA 1980). In an obviousness rejection, “[u]nder § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.” *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 15 - 17 (1966). With regard to the claims rejected under 35 U.S.C. § 103(a) in the current application, the Office Action does not show that the rejected claims are obvious under the framework set out in *Graham*. The Office Action, at least, does not reflect that the

differences between the applied art and the claims at issue have been properly ascertained. The rejected claims are considered below.

**A. Independent Claims**

1. Claim 1

Claim 1 recites, “abstracting . . . data bits from said data stream . . . wherein said data stream is provided by an application . . .” In asserting that Harman teaches the above limitation of claim 1, Examiner states that “job data 10, outputted by the applications . . . is parsed by parser 112 residing in the mail production apparatus (Fig. 5).” Office Action, page 3. Further, Examiner asserts that the application is taught by Harman’s reference to Microsoft Word. *Id.* However, in Harman, Microsoft Word does not provide a data stream to parser 112. Instead, mail center controller 4, through host interface 110, provides a data stream to parser 112. Fig. 3, col. 7, lines 44 – 48. Significantly, mail center controller 4 receives job data 10 from stations 2 and modifies the data by adding data from other sources. Col. 4, lines 35 – 36; Fig. 3 (showing mail controller combining three data streams to create one data stream). Moreover, the job data that enters mail center controller 4 is itself a product of driver 37, which combines at least a portion of the document data provided by Microsoft Word with data from access data store 38. *See* col. 4, lines 48 – 53; Fig. 3. Thus, Microsoft Word, in Harman, does not provide the data stream that parser 112 parses. It should be noted also that because claim 1 requires that the application “has not been adapted to control said additional functions . . .” driver 37 and mail center controller 4 do not teach an application as recited in the claims. Examiner therefore has not shown “abstracting . . . data bits from said data stream . . . wherein said data stream is provided by an application . . .”

Claim 1 also recites “said abstracting includes examining said data stream for data patterns native to output of said application . . .” Examiner cites to Fig. 2 and the parser 112 of Fig. 5 as teaching this limitation of claim 1. Because, as discussed above, the data stream parsed by parser 112 is made up of data from many sources, there is no showing that the parsing that occurs at parser 112 involves examining the data stream for data patterns native to the output of

the application. If any examination occurs at parser 112, it could be an examination of patterns established subsequent to data leaving the Microsoft Word application and prior to parsing by parser 112. Harman is silent as to what examination occurs at parser 112. Therefore, Examiner has not shown that Harman teaches abstracting includes examining the data stream for data patterns native to output of the application. Because the applied art does not teach all the limitations of claim 1, Applicant respectfully requests that Examiner withdraw the rejection, under 35 U.S.C. § 103, of claim 1.

2. Claim 17

Claim 17 recites “wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data.” Examiner cites to Harman, Fig. 2, col. 6, lines 1 – 3 and col. 4, lines 32 – 33. Office Action, page 10. These cited portions of Harman, however, teach that a postage value is appended to mail piece header 18 and that mail piece header 18 is separated by unique separators. Absent from these cited portions of Harman, however, is any teaching that abstracting includes examining the data stream for preestablished data patterns that include the beginning and ending of postage indicia data. Examiner asserts parser 112 carries out the abstraction. Office Action, page 9. As discussed above, Harman is silent as to what examination of the data stream occurs at parser 112. Examiner therefore has not shown that Harman teaches the limitation of claim 17 reciting “wherein said abstracting includes examining said data stream for preestablished data patterns, and wherein said preestablished data patterns include the beginning and ending of postage indicia data.” Accordingly, Applicant respectfully requests that Examiner withdraws the rejection, under 35 U.S.C. § 103, of claim 17.

3. Claim 23

Claim 23 recites, “calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed . . . .” Examiner cites to Harman, col. 5, lines 56 – 61 as teaching this limitation of claim 23. Office Action, page 12. However, in the rejection of claim 23, Examiner asserts that “a separate data stream” as recited in claim 23, is Harman’s “variable data.” *Id.* This variable data, however, is

created after the postage value is calculated—the opposite of what Examiner asserts. *See* col. 6, lines 4 – 8 (stating, “Once the postage value is determined . . . class 2 meter . . . returns the variable portion of the indicia to controller 100 . . . Controller 100 downloads this variable data to printer 66 . . .”). Thus, Examiner’s asserted separate data stream cannot control calculating an amount of postage to be applied because, in Harman, postage is calculated prior to the asserted separate data stream is created. Examiner, therefore, has not shown, the limitation of claim 23 reciting, “calculating under joint control of said secure memory and said separate data stream an amount of postage to be applied to a particular document to be printed . . .”

Accordingly, Applicant respectfully requests that Examiner withdraw the rejection under, 35 U.S.C. § 103, of claim 23.

#### 4. Claim 33

Claim 33 recites, “wherein said data stream is provided by an application . . .”

Examiner cites to Figures 2 and 5 of Harman as teaching this limitation of claim 33. Office Action, page 15. Figure 2, however, merely shows the components of job header 10. Figure 5 shows job data 10 is transferred to parser 112. As discussed with regard to claim 1, the job data that is parsed by parser 112 is not provided by the Microsoft Word application. Rather, the document data provided by the Microsoft Word application is combined with other data in processes at driver 37 and mail center controller 4. Col. 4, lines 35 – 36; Fig. 3 (showing mail controller combining three data streams to create one data stream); col. 4, lines 48 – 53; Fig. 3. The product of these processes—job data 10—is then sent to parser 112. Fig. 5; col. 7, lines 48 – 52. Moreover, because claim 33 requires that the application “has not been adapted to control said additional printing operations . . .” driver 37 and mail center controller 4 do not teach an application as recited in the claims. Examiner therefore has not shown that Harman teaches the limitation of claim 33 requiring “wherein said data stream is provided by an application . . .” Accordingly, Applicant respectfully requests that Examiner withdraw the rejection, under 35 U.S.C. § 103, of claim 33.

5. Claim 41

Claim 41 requires, “wherein said abstracting program includes a control program for examining said data stream for certain preestablished data patterns, and wherein said certain preestablished data patterns include the beginning and ending of postage indicia data.” Examiner cites to Harman, Fig. 2, col. 6, lines 1 – 3 and col. 4, lines 32 – 33. Office Action, page 18. After citing these portions of Harman, Examiner then concludes, “it is clear that the preestablished data patterns include the beginning and ending of postage indicia.” Office Action, pages 18 – 19. It should be noted, however, that the claim does not simply require the existence of beginning and ending of postage indicia data. Claim 41 requires an abstracting program which **examines** the data stream for the beginning and ending of postage indicia data. Thus, Examiner has not shown Harman teaches this limitation of claim 41.

Claim 41 requires a “separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia . . . .” Examiner cites to Harman col. 5, lines 55 – 50 as teaching this limitation of claim 41 and asserts that the disclosed variable data is a separate data stream as recited in the claim. Office Action, page 18. As discussed with regard to claim 23, however, this variable data, disclosed in the cited portion of Harman, on which Examiner relies, cannot control the postage indicia because it is created after the postage indicia has been calculated. Examiner, therefore has not shown the limitation of claim 41 requiring a “separate data stream for enabling at least one said ancillary printing operation, wherein said at least one ancillary operation comprises the printing of a postage indicia . . . .” Because Examiner has not shown Harman teaches all the limitations of claim 41, Applicant respectfully requests that Examiner withdraw the rejection, under 35 U.S.C. § 103, of claim 41.

**B. The Dependent Claims**

Claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, and 47 depend from claim 1; claims 24 – 27, and 30 – 32 depend from claim 23; and claims 34, 37 – 40, and 42 – 46 depend from claim 33. As discussed above, claims 1, 23 and 33 are patentable over the applied art. The dependent claims inherit all the limitations from their respective independent claims. For at least this

reason, claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are patentable over the applied art. Moreover, the independent claims themselves recite new and unobvious limitations that Examiner has not shown is taught in the applied art.

For example, claim 4 recites “wherein said at least one additional function further comprises a dialog box for allowing options from a user.” Examiner concedes that “Harman does not expressly disclose a dialog box for allowing options from a user.” Office Action, page 5. Examiner then asserts that this limitation is obvious because Harman teaches that controller 4 goes to an error routine if no capable apparatus is found in controller 4. This conclusion of obviousness, however, is inconsistent with *Graham*. As pointed out in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S.\_\_\_\_ (2007), “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.”

In the Office Action, Examiner asserts it would have been obvious to display a dialog box for the user to have an option to switch apparatus. Examiner makes this assertion even though the error routine, to which Examiner points, is activated when “no capable apparatus is found . . . .” See col. 9, lines 55 – 62. There is no rational reason for giving the user an option to switch apparatus if no capable apparatus exists. Examiner, therefore, has not provided a rational reason why the limitation of claim 4 is obvious.

Claim 6 recites, “wherein said at least one additional function further comprises directing the abstracted portion to multiple locations.” In asserting Harman teaches this limitation of claim 6, Examiner relies on the parser outputting document data to page description language interpreter and envelope data to envelope data buffer. Office Action, page 6. However, if either the document data or the envelope data is considered the abstracted portion, there is no showing in Harman that these data are sent to multiple locations. Rather, each set of data is sent to a single location—the page description language interpreter **or** envelope data buffer. Examiner, therefore, has not shown Harman teaches at least one additional function further comprises directing the abstracted portion to multiple locations as recited in claim 6.

Claim 12 recites, “wherein said printer driver is operable on said data stream coming from said application operating in a computing device to control at least a portion of the printing

of said printer.” Examiner relies on col. 5, lines 42 – 46 as teaching this limitation of claim 12. Office Action, pages 7 – 8. Examiner asserts, “mail finishing unit controller 100 stores mail piece attributes 40 from header 12 for default control of the production of each mail piece and downloads common elements of the address to be printed on the envelopes to envelope printer 66.” *Id.* However, mail finishing controller 100 receives **attribute data** from printer controller 58 after printer controller 58 has parsed the job data. *See* col. 5, lines 37 – 46. The downloading of elements of the address from mail finishing unit controller 100, therefore, does not teach the printer driver is operable on the data stream coming from the application operating in a computing device to control at least a portion of the printing of the printer.

Claim 21 requires that the abstracting of data bits includes examining the data stream for data patterns including the beginning and ending of each document. Examiner cites to “Fig 2, document data field 20” as teaching this limitation of claim 21. Office Action, page 11. Simply citing to the location of document data in a diagram representing the job data does not show that Harman teaches abstracting of data bits includes examining the data stream for data patterns including the beginning and ending of each document. It is not apparent to Applicant how Fig. 2, document data field 20 teaches the claim limitation at issue. *See* 37 C.F.R. § 1.104 (providing that “[t]he pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.”).

Claim 22 recites, “wherein said data patterns include the number of pages of a document.” The Examiner cites to column 3, lines 57-60, of Harman as teaching this limitation of claim 22. Office Action, page 11. However, the cited portion of Harman merely teaches that job header 12 includes the number of document sheets to be accumulated for each mail piece. Absent from this citation is any teaching that the abstracting of data bits includes examining the data stream for the number of pages of a document. Therefore, the Examiner has not shown that Harman teaches all the limitations of claim 22.

In rejecting claim 25, the Examiner relies upon Harman column 5, lines 42-45, as teaching copying from the data stream portions of the data stream. Office Action, pages 12 – 13. The identified portion of Harman, however, teaches mail finishing unit controller stores mail

piece attributes and downloads common elements of the address to be printed. Assuming, *arguendo*, that this is copying, the teaching is that the data stream sent to the mail finishing controller is attribute data that has been parsed from the job data by controller 58. *See* col. 5, lines 37 – 46. Thus, the mail finishing unit could only copy the parsed attribute data and has no opportunity to copy the data stream. Therefore, the Examiner has not shown Harman teaches copying from said data stream portions of said data stream, as required by claim 25.

Claim 26 requires copying portions of said data stream including address information with respect to a particular document to be printed. The Examiner cites to Harman col. 5, lines 42-45, as teaching this limitation of claim 26. Office Action, page 13. However, as discussed above, this citation teaches that the asserted copying occurs from the parsed attribute data and not the data stream. Thus, Examiner has not shown Harman teaches the limitations of claim 26.

Claim 27 requires creating, from the copied address information, a postage indicia. The Examiner cites to Harman column 6, lines 9-15, as teaching this limitation of claim 27, Office Action at page 13. In the cited portion of Harman, however, the controller downloads the address to the printer and the printer then franks the mail piece with postage indicia. There is no teaching here that the postage indicia is created from copied address information. In fact, as discussed above, the Examiner has not shown that there is any information copied from the data stream. Thus, the Examiner has not shown Harman teaches creating, from the copied address information, a postage indicia as required by claim 27.

Claim 31 recites, “wherein said reviewing step includes the step of enabling a dialog box.” Claim 32 recites, “wherein said dialog box interacts with a user to provide at least one of the following . . . .” In rejecting claims 31 and 32, Examiner concedes that “Harman does not expressly disclose the method of claim 23 wherein said reviewing step includes the step of enabling a dialog box and wherein said dialog box interacts with a user to provide . . . .” Office Action, page 13. Examiner then proceeds to make the same assertions as was done with regard to claim 4 to show that the limitations of claims 31 and 32 are obvious. Essentially, Examiner asserts it would have been obvious to display a dialog box for the user to have an option to



switch apparatus. As discussed with regard to claim 4, however, Examiner has not provided a rational reason why this would be obvious. Specifically, Examiner has not shown why a user would want to switch apparatus, in Harman, when there is no capable apparatus. The obviousness rejections of claims 31 and 32 are not proper under *Graham*.

Claim 40 recites, “a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application.” In rejecting claim 40, Examiner states “Figure 2 of Harman’s disclosure shows the patterns of the job data 10, outputted by the applications, which is parsed by parser 112 residing in the mail production apparatus. (Fig 5).” Office Action, page 17. However, Examiner has not shown that a control program pertaining to parser 112 examines the data stream for data patterns native to output of the application. It should be noted that mail center controller 4 has modified the job data that goes to parser 112. *See* col. 3, lines 25 – 29. Moreover, driver 37 generates job data 10 from two sources— (1) document data originating from a word processing application 30 and (2) data from data store 38. Fig. 3, Col. 4, lines 35 –47; col. 5, lines 37 – 42. Examiner, therefore, has not shown that Harman teaches the limitation “a control program for examining said data stream for certain preestablished data patterns, wherein said control program examines said data stream for data patterns native to output of said application.”

Claim 45 requires that a computer product includes a control program for examining the data stream for preestablished data patterns that include the beginning and ending of each document to be printed. Examiner cites to Harman, col. 4, lines 18 – 20 and Fig. 2 as teaching the limitations of claim 45. Office Action, page 19. However, the cited portions of Harman teach the “[d]ocument data 20 is mail piece data defining a sequence of document pages to be printed by the document printer . . . .” *Id.* This does not teach that a computer product includes a control program for examining the data stream for preestablished data patterns that include the beginning and ending of each document to be printed.

In sum, Examiner has not shown that dependent claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47 are rendered obvious by Harman. Accordingly,

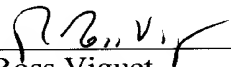
Applicant respectfully requests that Examiner withdraw the rejections, under 35 U.S.C. § 103, of claims 2 – 4, 6 – 14, 16, 18 – 19, 21 – 22, 24 – 27, 30 – 32, 34, 37 – 40, and 42 – 47.

#### **IV. Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-2380, under Order No. 61135/P016US/10106022 from which the undersigned is authorized to draw.

Dated: October 4, 2007

Respectfully submitted,

By   
R. Ross Viguet  
Registration No.: 42,203  
FULBRIGHT & JAWORSKI L.L.P.  
2200 Ross Avenue, Suite 2800  
Dallas, Texas 75201-2784  
(214) 855-8185  
(214) 855-8200 (Fax)  
Attorney for Applicant